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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,506	07/18/2000	Ian J. Forster	4579-048	8845

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EXAMINER

LEE, BENJAMIN C

ART UNIT PAPER NUMBER

2632

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,506

Applicant(s)

FORSTER ET AL.

Examiner

Benjamin C. Lee

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12, 14-22, 24-26, 34-46, 48-56, 58-60 and 64-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-12, 14-22, 24-26, 34-41, 48-56, 58-60 and 74-77 is/are allowed.
- 6) ☒ Claim(s) 42-46, 64 and 67-73 is/are rejected.
- 7) ☒ Claim(s) 65 and 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

RESPONSE TO AMENDMENT

Claim Rejections - 35 USC § 112

1. Claims 70 and 72-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In considering claims 70 & 72, how does communicating to the wireless communication device altering the magnetic force should be further defined, since “communicating” in essence or virtue does nothing else but “communicating”.

2) In claim 73, who or what is performing the altering and communicating should be further defined. For example, does the claimed invention contemplating a person performing those steps?

Claim Rejections - 35 USC § 103

2. Claims 42-46, 67-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canada et al. in view of Porco (US pat. #4,540,980) and Larin (US pat. #4,184,277).

1) In considering claims 42-43 & 45, Canada et al. disclosed all of the following claimed subject matter:

a) claimed device (Fig. 2) that magnetically attaches (col. 11, lines 4-14) to an article (machine to be monitored), comprising: a wireless communication device (Fig. 3), and a magnetic means having a magnetic force coupled to said wireless communication device for attaching said magnetic means to the magnetic surface portion of the article when in close

Art Unit: 2632

proximity to the magnetic surface portion of the article (inherent from col. 11, lines 13-14; col. 5, line 39 and Fig. 2);

except:

b) specifying that the magnetic means is a magnet and an external device/magnet that is brought into proximity to said magnet alters said magnetic force.

However, magnetic mounts implemented by a magnet has been known in the art, such as taught by Porco (13 in Figs. 2b-2c). Since Canada et al. teaches that the attachment means 404 in Fig. 2 can be a "magnetic mount", in view of the teachings by Canada et al. and Porco, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that such magnetic mount in a device such as taught by Canada et al. can be conventionally implemented by a magnetic such as taught by Porco.

The magnetic mount of the communication device taught by Canada et al and Porco constitutes a removable mount adapted for convenient removal of the communication device whenever desired. Furthermore, it has been known that in order to remove or diminish the magnetic force attraction between a magnet and a magnetic surface, an external device, such as an external magnet, can be brought into proximity to the magnet to alter/cancel the magnetic attractive force, such as taught by Larin (col. 3, lines 24-44 and Figs. 2 and 5a showing magnet 19a or 20a being attracted to article 21, and when external magnet A is brought into proximity, said magnetic attractive force is altered so that magnet 19a or 20a can be moved away from article 21). In view of the teachings by Canada et al., Porco and Larin, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention since Canada et al. teaches that the communication device sometimes is placed cramped locations (col. 5, lines 36-

Art Unit: 2632

41) which may be difficult to be accessed directly for removal, an external device such as taught by Larin can be used with a device such as taught by Canada et al. and Porco for ease of removing the communication device from cramped or other difficult-to-access locations.

2) In considering claim 44, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in claim 42, except:

--the claimed said external device is a signal field generator.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a signal field generator in the form of an electromagnet constitutes a functional equivalence to the external magnet in a system such as taught by Canada et al., Porco and Larin, and therefore such electromagnet can be used interchangeably as the external magnet without unexpected results.

3) In considering claim 46, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in claim 42, wherein:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that an external magnet with a strong pull facilitates removal of the communication device from its mounted surface in a system such as taught by Canada et al., Porco and Larin so that it is desirable to use such strong external magnet, wherein using such a strong external magnet effectively moves said magnet with respect to said magnetic surface portion.

4) In considering 67, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in the consideration of claim 44, wherein:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that when the intended mounting surface for the communication device in a system

Art Unit: 2632

such as taught by Canada et al., Porco and Larin is a surface of a portable article, then the removal process can be commenced either by bringing the communication device in proximity to the signal generator, or vice versa without unexpected results.

5) In considering 68, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in the consideration of claim 46.

6) In considering 69, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in the consideration of claim 42, except:

--specifying the claimed shorting said magnet.

Since the system of Canada et al., Porco and Larin teaches altering the magnetic force attraction between the magnet and the surface by altering the magnetic field of the magnet, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that other similar methods such as shorting the magnet to alter its magnetic field and thus its magnetic force attraction can be used to achieve the same removal result.

7) In considering claim 71, Canada et al., Porco and Larin made obvious all of the claimed subject matter as in claim 69, plus the consideration of claim 44, wherein:

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a combination of ways for removal of the magnetic force attraction to remove the communication device from its mounting surface in a system such as taught by Canada et al., Porco and Larin can be used for their combined effect to provide improved or quicker removal without unexpected results.

3. Claims 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canada et al. in view of Porco.

Art Unit: 2632

1) In considering claims 42 and 46, Canada et al. disclosed all of the following claimed subject matter:

a) claimed device (Fig. 2) that magnetically attaches (col. 11, lines 4-14) to an article (machine to be monitored), comprising: a wireless communication device (Fig. 3), and a magnetic means having a magnetic force coupled to said wireless communication device for attaching said magnetic means to the magnetic surface portion of the article when in close proximity to the magnetic surface portion of the article (inherent from col. 11, lines 13-14; col. 5, line 39 and Fig. 2);

except:

b) specifying that the magnetic means is a magnet and an external device is brought into proximity to said magnet to alter said magnetic force by moving said magnet with respect to said magnetic surface portion.

However, magnetic mounts implemented by a magnet has been known in the art, such as taught by Porco (13 in Figs. 2b-2c). Since Canada et al. teaches that the attachment means 404 in Fig. 2 can be a "magnetic mount", in view of the teachings by Canada et al. and Porco, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that such magnetic mount in a device such as taught by Canada et al. can be conventionally implemented by a magnetic such as taught by Porco.

The magnetic mount of the communication device taught by Canada et al and Porco constitutes a removable mount adapted for convenient removal of the communication device whenever desired. Since Canada et al. teaches that the communication device sometimes is placed cramped locations (col. 5, lines 36-41) which may be difficult to be accessed directly for

Art Unit: 2632

removal, an external device such as an elongated removal stick or probe can be used push on the communication device such as taught by Canada et al. and Porco so that the magnet and communication device move with respect to the magnetic surface portion so as to overcome the magnetic attractive force in lieu of the movement as well as gravity to facilitate ease and convenience of removal.

4. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canada et al. in view of Thomson et al.

1) In considering amended claim 64, Canada et al. and Thomson et al. made obvious all of the claimed subject matter as in the consideration of claim 64 as in the previous Office action, wherein:

--the claimed detaching the wireless communication device from the magnetic surface portion by activating a latch coupled to said magnet thereby rotating the magnet and altering the magnetic force is met by Fig. 3 of Thomson et al. in which the adjustor 33 having portion 34 attached to magnet 36 constitutes the latch, protruding into cavity shown in the figure that prevents relative lateral movement of the assembly and its portions and holding/latching the magnet in position by way of the threaded coupling, and when the latch is rotated, it rotates and retracts outward of the cavity, thereby rotating and bringing the magnet 36 with it away from the magnetic surface and thereby reducing its magnetic attraction and detaching the assembly from the magnetic surface.

Allowable Subject Matter

5. Claims 8-12, 14-22, 24-26, 34-41, 48-56, 58-60 and 74-77 allowed.

Art Unit: 2632

6. Claims 65-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to claims rejected above have been considered but are moot in view of the new ground(s) of rejection.

--See above rejection for detail.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Chen, US pat. #5,121,098

--A similar alarm device using magnetic mount.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (703) 306-4223.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

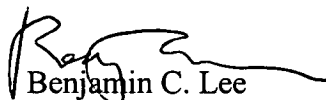
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (703) 308-6730. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8576.

Application/Control Number: 09/618,506

Page 9

Art Unit: 2632

A handwritten signature in black ink, appearing to read "Benjamin C. Lee", with a stylized flourish extending to the right.

Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.

March 23, 2003